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NOV. 24, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Profiles Corporation

Serial No. 75/057,816

Ralph H. Lane of Pattishall McAuliffe Newbury Hilliard &
Geraldson for applicant.

Irene Williams, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Quinn, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant, Profiles Corporation, an Iowa corporation,
has filed an application for registration of the mark
"INSIDE THE SAT" for a wide variety of educational testing

preparation materials in Int. Class 16 and for educational services in Int. Class 41.¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, "INSIDE THE SAT," when used on these educational test preparation services and materials, so resembles the registered mark, "SAT," as applied to "printed tests and test booklets," as to be likely to cause confusion, or to cause mistake, or to deceive.²

Applicant has appealed the final refusal to register. Briefs have been filed but applicant did not request an oral hearing. We affirm the refusal to register.

¹ Serial No. 75/057,816, filed February 14, 1996, alleging use in both classes since September 1992. While the original application listed items in Int. Class 9, these goods were deleted in response to the first Office action. The identification of goods in Int. Class 16 as amended now reads as follows: "Kits comprising books, workbooks, worksheets, charts, diagrams, videotapes, video disks, computer programs, CD-ROMs, practice tests, teachers' and presenters' manuals, or kits comprising practice tests and at least one of the aforesaid goods, all in the field of educational test preparation; books, workbooks, worksheets, charts, diagrams, practice tests, teachers' and presenters' manuals, all in the field of educational test preparation." The recital of services in Int. Class 41 now reads as follows: "Educational services, namely, conducting classes, workshops, and tutorials in the field of educational test preparation." Applicant is also prosecuting a co-pending application, SN 75/202,389, for the matter "INSIDE THE SAT" applied to goods in Int. Cl. 9.

² Registration No. 1,067,665, issued on June 14, 1977. The registration sets forth dates of first use of May 1947; §8 affidavit accepted & §15 affidavit received; renewed.

In the course of rendering this decision, we have followed the guidance of In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), that sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

The record shows that registrant's cited mark is an initialism comprising the letters S-A-T.³ This is derived from the abbreviation of "Scholastic Aptitude Test" -- a national, standardized test taken by college-bound high school students. Universities then utilize each student's individual score in making their respective decisions about college admission or placement.

Applicant concedes that registrant's mark cited by the Trademark Examining Attorney is contained within applicant's mark. That is, the initialism, "SAT," has been adopted in a form identical to registrant's mark and it is included in applicant's mark in its entirety. However, applicant then goes on to argue that fact alone is not at all determinative of likelihood of confusion in this case. It points to the way in which members of its industry use registrant's mark in their publications, as well as the

³ In our experience, this designation is most often spoken as if an initialism comprising three letters of the alphabet, not as an acronym pronounced "sat."

differences between registrant's tests and applicant's goods and services in the area of test preparation.

Applicant discusses where on the "fanciful-suggestive-descriptive" continuum the designation "SAT" falls when applied to standardized tests. It answers this question by insisting that "SAT" is so widespread in its usage as to often become highly descriptive, or even generic in some contexts. Specifically, applicant argues that in the industry that has grown up around test preparation services and materials, substantially all the for-profit vendors in the marketplace will use the SAT designation in their titles, workshop advertisements, etc. As a result, applicant contends it is the other matter in each of these titles that serves as a distinguishing source indicator (i.e., in this case, the "INSIDE THE. . ." portion of the title).

While there are obvious differences between applicant's mark and registrant's mark, we conclude that the marks are similar in overall commercial impression. Registrant's entire mark is the designation SAT. Applicant's mark contains registrant's mark in its entirety. It is well settled that "a subsequent user may not appropriate another's entire mark and avoid likelihood

of confusion . . . by merely adding descriptive or otherwise subordinate matter to it." R.J. Reynolds Tobacco Co. v. R. Seelig & Hille, 201 USPQ 856 (TTAB 1978) ["SIR WINSTON" for tea likely to cause confusion with "WINSTON" for cigarettes]. Applicant argues that since it filed a disclaimer of the designation "SAT", the only issue of registration relates to the words "INSIDE THE . . ." But the filing of a disclaimer with the Patent and Trademark Office does not remove the disclaimed matter from our review when making a determination of likelihood of confusion. See In re National Data Corp., 753 F.2d 1056, 1058-59, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (rejecting the "tactical strategy" of disclaimer filing, in determination of likelihood of confusion). In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed.Cir. 1993).

Reasonable people may differ as to what comprises the dominant portion of applicant's mark, or indeed, whether this unitary phrase even has a dominant element. However, as a registered trademark, the SAT designation is conceptually the dominant part of applicant's title.

In this context, it is instructive to examine more closely applicant's specimens of record:



As can be seen from the excerpt above, the SAT portion of applicant's alleged mark is placed in a large and most prominent manner on the cover of applicant's guidebook.⁴ While applicant has come in for a typed drawing, such a registration would in no way restrict the size or style of lettering for various portions of the mark. Clearly, applicant has chosen to portray the SAT portion of its title most prominently on the guidebook cover.⁵

⁴ This illustration above shows the correct proportions of the lettering on applicant's guidebook cover but is smaller than actual size. The word "INSIDE" is $\frac{3}{4}$ " tall, the word "THE" is $\frac{1}{4}$ " tall, and the designation "SAT" is $2\frac{1}{4}$ " tall. Proportionately, that means the designation "SAT" is three times as tall as the word "INSIDE" and nine times as tall as the word "THE."

⁵ Perhaps coincidentally, on registrant's materials as submitted for the record by applicant, the College Board had centered the designation SAT on the page, using similarly sized letters (approximately 3" tall) while employing a similar font.

An asterisk next to the term SAT on the title page of applicant's booklet correctly points to a notation on the following page that "SAT is a registered trademark of the College Entrance Examination Board." Furthermore, it should be noted that the cited registration for "SAT" issued under Section 2(f) of the Trademark Act after an *ex parte* examination. The Office may well have concluded in the late '70s that the abbreviation for Scholastic Aptitude Test was initially merely descriptive. However, as the owner of a mark registered under Section 2(f), registrant is entitled to a presumption that its marks had acquired distinctiveness as of date of registration. *Aromatique Inc. v. Gold Seal Inc.*, 28 F.3d. 863, 31 USPQ2d 1481 (8th Cir. 1994). 3 McCarthy on Trademarks and Unfair Competition, §15.34 at 15-53 (4th ed. 1998).

Applicant cannot make a collateral attack in this *ex parte* proceeding on the validity of the cited registration by alleging that it is descriptive. The registered mark must be afforded the presumptions of the statute. See Section 7(b) of the Lanham Act of 1946; *In re American Heritage Publishing Co., Inc.*, 172 USPQ 247 (TTAB 1971), *aff'd without op.*, 487 Fed.2d 1407, 180 USPQ 142 (CCPA 1973); 3 McCarthy on Trademarks and Unfair Competition, §23.80 at 23-168 (4th ed. 1996).

Furthermore, the cited registration is incontestable. Section 33(b) of the Lanham Act provides that this registration is *conclusive* evidence of the registrant's exclusive right to use the mark, subject to the conditions of §15 and the seven defenses enumerated in §33(b) itself. Mere descriptiveness is not recognized by either §15 or §33(b) as a basis for challenging an incontestable mark. *Park 'N Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 330 (Sup.Ct. 1985).

Applicant has urged us to take notice of the "SAT" and "S.A.T." entries in The American Heritage Dictionary of the English Language in reaching the conclusion that these designations are suspect as source indicators. However, to the extent that both dictionary entries list the definition as "Scholastic Aptitude Test," (with the leading letters "S," "A," and "T" all capitalized), these two dictionary entries and their definition could also be seen as accurately reflecting several of registrant's trademarks.

Furthermore, when viewed as a whole, applicant's alleged mark has a connotation that adds to the likelihood of confusion. The feature in applicant's mark which is different from the registered mark ("INSIDE THE . . . "), in our view, is not sufficiently different to distinguish

the marks to members of the public. In fact, to the contrary, the formulation "INSIDE THE SAT" might well suggest to the customer that these test preparation materials were assembled by "insiders" -- such as employees of the College Board or the Educational Testing Service -- having special knowledge because they are the test makers.⁶

As to the nature of the goods and services, there is a strong relationship between registrant's tests and test booklets, on the one hand, and applicant's preparation materials and educational services, on the other. The sole reason one takes advantage of applicant's test preparation services is to prepare for registrant's tests, or to try to improve upon one's earlier score. Similarly, even for the person who does not choose to attend applicant's classes, applicant's printed materials would have absolutely no market absent registrant's tests.

Applicant has submitted copies of registrant's advertising materials. It argues that these materials put out by the College Board itself demonstrate typical uses (and misuses) of the term "SAT." What these papers do show is that there is currently more overlap in the goods and services than even registrant's identification of goods

⁶ See footnote 8, *infra*.

would suggest. In addition to providing ten prior tests, registrant's materials claim to provide "advice from The College Board" on how to prepare for the tests. Reference is made to a variety of videos⁷, software and other types of interactive products, full-length practice tests and on-line services designed to help high school students prepare for the College Board's college entrance examinations. Similarly, the front of applicant's study guide tells the potential purchaser that the book contains "general test-taking strategies" and "three complete practice tests." This is entirely consistent with the identification of goods in the trademark application itself. So according to the record compiled by applicant, the parties are actually competing in the area of preparation and review materials and/or services to help students prepare for these important educational tests.

As to the care exercised by purchasers, it is debatable whether the prototypical adolescent eager to find any information promising to help prepare for this American rite of passage could be characterized as "sophisticated."

⁷ Whether focusing on the connotation of the marks, or the types of goods and services each party offers, it is interesting to observe that one of the videotapes for sale from registrant -- the College Board itself -- is entitled "Look INSIDE THE SAT I - Test Prep from the Test Makers."

Applicant has provided for the record a long listing of titles in this special field. In fact, one can envision an entire shelf in the local bookstore holding a bewildering array of these materials -- relatively inexpensive study guides, test-taking "tip" books and other related paperback booklets having practice tests, software, etc. The high school student might well base her purchasing decision on the lowest priced offering, the book having the snappiest graphics, the most sophisticated software, the one with the greatest heft, or the book from the publisher touting the best track record. On a "conditions of sale" continuum, extending from sophisticated professionals buying expensive items all the way to "impulse purchases" made by everyday consumers, arguably the teen-ager looking for test preparation materials falls toward the latter end of the spectrum.

As noted earlier, applicant points out that there are many others in the test preparation business who also use the term SAT within the titles of published works. However, none of these other titles *qua* publication titles are before the Board today for a determination of their fitness for federal trademark registration. Conversely, if the federal trademark registry were replete with third-party composite marks including the term SAT that had been

registered for goods/services related to the college admission process or college entrance examinations, presumably applicant would have brought that dilution of the term to the Board's attention for our consideration.

Applicant would have us focus on whether a myriad of third-party uses of the term SAT in the titles of test preparation materials comprise "fair use" of this designation. Descriptive designations may become trademarks and subject to protection as such without inhibiting the use of the same words in a non-trademark sense. For example, should the College Board bring an infringement action against any of the purveyors of the many guidebooks or seminars listed by applicant, "fair use" under section 33(b)(4) of the Act may well be posited as an affirmative defense by this hypothetical defendant. However, even if it were stipulated herein that these publications are actually present in the marketplace, that plethora of third-party usage in publication titles is not necessarily traditional trademark usage and hence is not relevant to our determination under Section 2(d) of the Lanham Act.

Decision: Thus, we agree with the Trademark Examining Attorney's conclusion that applicant's mark is likely to

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cause confusion with the registered mark and affirm the refusal to register.

T. J. Quinn

P. T. Hairston

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board